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Filed : October 1, 1997

#### Discussion of Amendments to the Specification

Applicant has amended the specification in several places to replace incorrect reference numbers and to fix grammatical errors. Additionally, Applicant has amended pages 10-12 to reflect proper use of the trademark "I2C," as requested by the Examiner and further discussed below. Applicant submits that the amendments to the specification do not add any new matter, and that the inserted corrections are fully supported by the disclosure for the above-referenced patent application.

#### Discussion of the Use of Trademarks

In paragraph 2 of the Office Action, the Examiner objected to the disclosure because each letter of the trademark I2C was not capitalized when used in the application. Applicant respectfully notes that in fact each *letter* of the trademark I2C is capitalized whenever used in the application. Nonetheless, Applicant has submitted substitute pages 10-12, where now the trademark at issue appears as "I2C," rather than "I<sup>2</sup>C." Thus, Applicant submits that the Examiner's objection to the disclosure is now overcome.

#### Discussion of Amendments to the Claims

Claims 1-19 were pending in the parent application, from which this application depends as a continuing application. Claims 1, 11, and 19 have been amended by this paper. Claims 2-10 and 12-18 remain unchanged by this amendment. This amendment adds new Claims 20-28. Hence, by this paper, Claims 1-28 are presented for examination.

Applicant submits that the new and amended claims do not add any new matter. Applicant submits that these features are fully supported by the disclosure for the above-referenced patent application. *See, e.g.,* page 9, line 29 – page 10, line 4, Fig. 4, Fig. 5A, and Fig. 5B.

#### Discussion of the Claim Rejections under 35 U.S.C. §§ 102(b) and 103(a) over Barrett

In the Office Action mailed April 26, 2000, Claims 1-6, 9-17, and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,311,451 to Barrett. Claims 7, 8, and 18 were rejected under 35 U.S.C. § 103(a) as also being unpatentable over

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Barrett. Applicant submits that nowhere does Barrett teach or suggest all the limitations of independent Claims 1, 11, or 19, as amended.

In rejecting Claims 1-6, 9-17, and 19, the Examiner stated that "Barrett teaches the use of a reconfigurable controller and monitor comprising: a method of mapping resources to memory (abs., and col. 2, lines 35 et seq.), a microcontroller network (fig. 1), a central computer (25), interconnection path ways (23), sensors (19), buffering messages (requests, col. 3, lines 20 et seq.), log notification of a fault (col. 18, lines 4 et seq.), canisters (I/O devices, col. 14, line 14), a client computer (col. 1, lines 63 et seq., col. 2, lines 10 et seq.), an actuator/variable speed fan (col. 6, lines 19 et seq.), a timer (col. 14, lines 12 et seq.), a manual and software reset, (col. 18, lines 20 et seq.), a temperature sensor 19, a display (27), checking voltage (col. 13, lines 15 et seq[.]), and executing commands (col. 1, lines 48 et seq., and col. 3, lines 23 et seq.) logging conditions (Rams, 314, 520)."

However, Applicant respectfully submits that Barrett is directed to a computer system for monitoring and controlling climate conditions *external* to the computer; for example, such "a control system (11) monitors and controls climate conditions in a large office building." (Col. 3, Lines 15-16). More specifically, the system of Barrett monitors and controls air duct baffles (316) which are located *external* to a personal computer (25). In Barrett, the personal computer (25) is connected to a plurality of controllers (13) via a data concentrator (23). However, as can be seen by a visual inspection of Figure 1, the data concentrator (23) and the controllers (13) are *external* to the computer and are used to monitor remotely located baffles (316). Applicant respectfully submits that Barrett does not monitor the environmental conditions *within* the computer (25).

In contrast, Applicant respectfully submits that Claim 1, as amended, recites the element of "a plurality of sensors, *located within the computer*, capable of sensing conditions *within* the computer," as well as the element of "a microcontroller network, *located within the computer*." (emphasis added). Furthermore, Claim 11, as amended, recites the element of "a plurality of microcontrollers, *located within the computer* . . . wherein the microcontrollers manage the conditions *within* the computer." (emphasis added). Finally, Claim 19, as amended, recites the limitation of "means, *located within the computer*, for sensing the *internal* conditions of the computer with the microcontroller network." (emphasis

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added). Hence, the system claimed by Applicant allows for the monitoring and controlling of the environmental conditions *within* the computer *itself*—this is a function which Barrett's system cannot perform.

In paragraph 7 of the Office Action, the Examiner stated that Barrett teaches "sensing a plurality of conditions of the computer system (col. 14, lines 12 et seq.)." Barrett, however, teaches that "[o]perating under the instruction of its control algorithm, microcontroller 519 periodically enables each input and output device. Upon being enabled, an input device places input data which includes measured parameters sensed by an *external sensing device* . . ." (Col. 14, Lines 14-19). (emphasis added). Applicant submits, first, that Barrett shows a microcontroller (519), as well as the other microcontrollers, residing in a location *external* to the computer. This is in sharp contrast to Applicant's device where the microcontrollers are located *within* the computer. Additionally, Applicant submits, the *external sensing device* referred to by Barrett is any of the sensors *external* to the computer, such as temperature sensor (317) and air flow sensor (321) (see Fig. 3). Applicant respectfully submits, then, that Barrett does not teach sensing a plurality of conditions *within* the computer, and, therefore, Barrett does not teach or suggest Applicant's claims.

Accordingly, Applicant submits that Barrett does not teach or suggest Applicant's claims since the sensors and microcontrollers shown in Barrett are neither located *within* the computer nor monitor and control the conditions *within* the computer. Therefore, Applicant respectfully requests that the rejection of Claims 1, 11, and 19 be withdrawn and the claims be allowed. Additionally, since Claims 2-10 and 12-18, are dependent on respectively one of independent Claims 1 and 11, pursuant to 35 U.S.C. § 112, ¶4, they incorporate by reference all the limitations of the claims to which they refer. Consequently, Applicant submits that Claims 2-10 and 12-18 are allowable. Hence, Applicant respectfully requests that the rejections of the dependent Claims 2-10 and 12-18 be withdrawn and the claims be allowed.

Discussion of Claim Rejections under 35 U.S.C. § 103(a) over Tavallaei

Claims 1-11 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tavallaei et. al. in view of Lakin. Prior to the filing of the present Continued Patent

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Application (CPA), Applicant submitted a *Declaration under 37 C.F.R. §1.131 to Overcome Tavallaei* (hereinafter "Declaration") with the intention to show that Applicant's invention antedated the Tavallaei reference. The Examiner objected to the Declaration on the grounds that the Declaration (a) "is signed by Walter Wallach, who is not a named inventor to the provisional application to which priority is claimed, nor inventor of the subject matter that is purported to be the basis for the declaration," and (b) "failed to submit factual information showing a completion of the invention."

With regard to the first ground of rejection, Applicant respectfully notes that Walter Wallach is in fact an inventor of the claimed subject matter. Walter Wallach is not only a named inventor in the regular application, but he is also a named inventor in U.S. Provisional Patent Applications No. 60/047,016 and No. 60/046,416, to which the regular application claims priority. It is true that some of the exhibits supporting the Declaration, and now also the Substitute Declaration, show Karl Johnson as the only author of the exhibits. That fact does not reflect that Karl Johnson was the sole inventor of the subject matter depicted in the exhibits; rather, it merely shows that the other three inventors delegated responsibility for documenting some aspects of the invention to Karl Johnson. Therefore, Applicant respectfully submits that any objections based on the proposition that Walter Wallach is not an inventor of the claimed subject matter are now overcome.

With regard to the second ground of rejection, Applicant submits a substitute *Declaration under 37 C.F.R. § 1.131 to Overcome Tavallaei* (hereinafter "Substitute Declaration"). As required by 37 C.F.R. § 1.131(a)(1), the Substitute Declaration presents facts showing completion of the invention in this country before the filing date of the application on which the domestic patent issued. The showing of facts is such, in character and weight, as to establish reduction to practice prior to the effective date of the reference—satisfying the requirements of 37 C.F.R. § 1.131(b). In support of the sufficiency of the Substitute Declaration, Applicant respectfully notes that "[a]n accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself." (M.P.E.P. 715.07). Additionally, "averments made in a 37 C.F.R. 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his own affidavit or declaration if he so elects." *Id.*

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The Substitute Declaration shows that at least by December 19, 1996, a product physically embodying the claim elements recited in independent Claims 1, 11, 19 and 20 was conceived, built, and made commercially available. Hence, the Substitute Declaration is sufficient to show that "the apparatus actually existed and worked for its intended purpose" by December of 1996. (M.P.E.P. § 715.07). Since Tavallaei was filed on December 31, 1996, (i.e., after Applicant reduced to practice the claimed subject matter) Applicant respectfully submits that the Examiner's rejection of Claims 1, 11, and 19 based on Tavallaei must be withdrawn. (M.P.E.P. § 715). Consequently, Applicant submits that independent Claims 1, 11, and 19 are in condition for allowance. Furthermore, since Claims 2-10 and 12-18 are respectively dependent on independent Claims 1 and 11, pursuant to 35 U.S.C. § 112, ¶4, they incorporate by reference all the limitations of the claim to which they refer. Hence, the rejection of the dependent Claims 2-10 is now overcome, and Applicant respectfully submits that dependent Claims 2-10 and 12-18 also are now in condition for allowance.

The Substitute Declaration has been signed by Karl S. Johnson, Walter Wallach, and Carlton G. Amdahl, who are named inventors of the application. Ken Nguyen, the remaining named inventor in the application, has so far failed to respond to an overnight letter mailed to his last known address on August 18, 2000. Additionally, as shown by the VERIFIED STATEMENT OF JOHN N. KANDARA, Applicant was unsuccessful in attempts to locate Mr. Nguyen using telephone directory listings for San Jose, California, i.e., Mr. Nguyen's last known place of residence. Because Applicant was unable to identify a phone number at which Mr. Nguyen could be reached, no further efforts have been made to reach Mr. Nguyen by telephone.

Mr. Kandara's statement was submitted in support of a patent application (Application No. 08/942,448) related to this case, for which Mr. Nguyen is also a named inventor. Since the facts concerning Applicant's attempt at locating Mr. Nguyen are the same in either case, Applicant respectfully submits that Mr. Kandara's statement also supports the present application. Consequently, Applicant has shown that reasonable steps have been taken to locate Mr. Nguyen in order to obtain his signature for the Substitute Declaration; nonetheless, Applicant has been unsuccessful in his efforts. Applicant

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respectfully submits, however, that "where it is shown that a joint inventor . . . refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient." M.P.E.P. § 715.04. Thus, Applicant respectfully submits that the Substitute Declaration is sufficient, both in substance and form, such that the Examiner should withdraw his objections to the claims based on Tavallaei.

### CONCLUSION

Applicant has endeavored to address all of the Examiner's concerns as expressed in the previous Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of the claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the capacity of the claims to particularly and distinctly point out the invention to those of skill in the art. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner finds any further impediment to allowing all claims that can be resolved by telephone, the Examiner is respectfully requested to call the undersigned.

Respectfully submitted,

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Dated: 8/24/00

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